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MAILED

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OFFICE OF PETITIONS

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|-------------------------------------|---|----------------------------|
| In re Application of | : | |
| Hongwei Yuan et al. | : | DECISION ON APPLICATION |
| Application No. 10/591,358 | : | FOR PATENT TERM ADJUSTMENT |
| Filed: August 12, 2008 | : | |
| Attorney Docket No. 57070-8021.US00 | : | |

This is in response to the paper filed June 21, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(b). The petition requests the initial determination of patent term adjustment be corrected from zero (0) days to eight hundred twenty-two (822) days.

The petition is **dismissed**.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) on April 14, 2010, advising Applicants of a patent term adjustment to date of 0 days. In response, Applicants timely filed the instant petition on June 21, 2010, prior to submitting the issue fee on July 14, 2010.

Applicants assert the correct patent term adjustment is 822 days, which is the sum of 623 days of delay under 37 C.F.R. § 1.702(a) ("A Delay") and 310 days of delay under 37 C.F.R. § 1.703(b) ("B Delay") reduced by 111 days of delay under 37 C.F.R. § 1.704(c) (Applicant Delay").

A Delay

Applicants argue the patent term adjustment should include a 623-day increase for delay under 37 C.F.R. § 1.702(a)(1), which provides for an adjustment if the Office fails to:

Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application.

Applicants assert the 14-month time period set forth in 37 C.F.R. § 1.702(a)(1) began on the filing date for the application which Applicants assert is August 14, 2006.

The instant application was not filed under 35 U.S.C. § 111(a). Instead, the application is the national stage of an international application. Therefore, the 14-month time period began on the date the application fulfilled the requirements of 35 U.S.C. § 371.

The application fulfilled the requirements of 35 U.S.C. § 371 on August 12, 2008. The Office mailed an action under 35 U.S.C. § 132 on June 29, 2009, which was less than 14 months after the date the application fulfilled the requirements of 34 U.S.C. § 371. Therefore, an increase in patent term adjustment for delay under 35 U.S.C. § 154(b)(1)(A)(i) and 37 C.F.R. § 1.702(a)(1) is not warranted.

B Delay

To the extent Applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the request is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. *See* 37 C.F.R. § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the 37 C.F.R. § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 C.F.R. § 1.702(a)(4) or applicant delay under 37 C.F.R. § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 C.F.R. § 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature.

Rather than file an application for patent term adjustment under 37 C.F.R. § 1.705(b) contesting the 37 C.F.R. § 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 C.F.R. § 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 C.F.R. § 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 C.F.R. § 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.¹

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 C.F.R. § 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 C.F.R. § 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 C.F.R. § 1.705(d) and must include payment of the required fee under 37 C.F.R. § 1.18(e).

Applicant Delay

Delay Under 37 C.F.R. § 1.704(b)

The petition asserts the period of Applicant Delay is 111 days. The petition states, with emphasis in the original,

On 22 February 2008, the Office mailed a Notice of Missing Parts. Applicants' response was due on 22 April 2008, but was not filed until 12 August 2008. Thus Applicants' delay resulted in a debit of 111 days.

37 C.F.R. § 1.704(b) provides for a reduction when a party takes more than 3 months to respond to any notice or action by the Office making any rejection, objection, argument or other request. Specifically, 37 C.F.R. § 1.704(b) states,

[A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

Applicants indicate a reply to the Notice to File Missing Parts was due on April 22, 2008, but was not filed until August 12, 2008, which was 111 days after the due date. However, as stated in 37 C.F.R. § 1.704(b), "The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph."

The period of delay under 37 C.F.R. § 1.704(b) is 82 days, which is the number of days beginning on May 23, 2008, the day after the date *three months after* the Office mailed the Notice to File Missing Parts, and ending on August 12, 2008, the date the reply was filed.

The Office did not enter a reduction in patent term adjustment under 37 C.F.R. § 1.704(b) when calculating the initial patent term adjustment. However, in view of the discussion above, an

action or notice of allowance. See 37 C.F.R. § 1.705(b) and 35 U.S.C. § 154(b)(3)(B). A dispute as to the calculation of the 37 C.F.R. § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 C.F.R. § 1.705(d) will be dismissed as untimely filed.

82-day reduction in patent term adjustment is warranted under 37 C.F.R. § 1.704(b). Therefore, the Office has entered an 82-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b).

Delay Under 37 C.F.R. § 1.704(c)(8)

The Office entered a 23-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8) prior to calculating the initial patent term adjustment determination.

Applicants do not *explicitly* dispute the Office's entry of a 23-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8). However, Applicants *implicitly* dispute the reduction by asserting the total period of Applicant delay is 111 days consisting of 111 days of delay under 37 C.F.R. § 1.704(b).

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

Applicants filed a reply to a June 29, 2009 Office action on July 29, 2009. Applicants subsequently filed an information disclosure statement ("IDS") on August 21, 2009. The record fails to indicate the Office expressly requested the IDS and the IDS was not accompanied by a statement under 37 C.F.R. § 1.704(d). The number of days beginning July 30, 2009, the day after the date a reply to the June 29, 2009 Office action was filed, and ending on August 21, 2009, the date the IDS was filed, is 23 days. Therefore, entry of a 23-day reduction under 37 C.F.R. § 1.704(c)(8) was warranted and proper.

Conclusion

The period of A Delay is 0 days.

Applicants' argument that the period of B Delay is at least 310 days is premature.

The Office has entered an 82-day reduction in patent term adjustment for delay under 37 C.F.R. § 1.704(b).

The total period of Applicant Delay is 105 days, which is the sum of 82 days of delay under 37 C.F.R. § 1.704(b) and 23 days of delay under 37 C.F.R. § 1.704(c)(8).

The period of A Delay is less than the period of Applicant Delay. The Office does not set forth negative balances of patent term adjustment when issuing a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b). Therefore, the Office properly notified Applicants the initial patent term adjustment is 0 days when the Office issued the Notice of Allowance.

Submission of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicants are reminded that any delays by the Office pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 C.F.R. § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director
Office of Petitions



Patent Term Adjustments



PTA/PTE Information **Patent Term Adjustment** Patent Term Extension

Application Number*: 10591358

Search

Explanation of PTA Calculation

Explanation of PTE Calculation

PTA Calculations for Application: 10591358

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|------------------------------------|---|
| Application Filing Date 08/12/2008 | Overlapping Days Between (A and B) or (A and C) 0 |
| Issue Date of Patent | Non-Overlapping USPTO Delays: 0 |
| A Delays 0 | PTO Manual Adjustment: 82 |
| B Delays 0 | Applicant Delay (APPL): 23 |
| C Delays 0 | Total PTA (days) 0 |

* - Sorted Column

File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---------------|----------------------|-----------------|-------------|---|--------------|---------------|----------------------|
| 59 | 11/26/2010 | | P020 | Adjustment of PTA Calculation by PTO | 0 | 0 | 0 |
| 45 | 04/14/2010 | | MN/ | Mail Notice of Allowance | 0 | 0 | 0 |
| 44 | 04/09/2010 | | TREV | Issue Revision Completed | 0 | 0 | 0 |
| 43 | 04/09/2010 | | N/ | Notice of Allowance Data Verification Completed | 0 | 0 | 0 |
| 42 | 04/09/2010 | | DVER | Document Verification | 0 | 0 | 0 |
| 41 | 04/08/2010 | | EXA | Examiner's Amendment Communication | 0 | 0 | 0 |
| 40 | 04/08/2010 | | CHTA | Notice of Allowability | 0 | 0 | 0 |
| 35 | 02/21/2010 | | FWDX | Date Forwarded to Examiner | 0 | 0 | 0 |
| 34 | 01/20/2010 | | A | Response after Non-Final Action | 0 | 0 | 0 |
| 31 | 10/20/2009 | | MCTNF | Mail Non-Final Rejection | 0 | 0 | 0 |
| 30 | 10/19/2009 | | CTNF | Non-Final Rejection | 0 | 0 | 0 |
| 21 | 08/28/2009 | | FWDX | Date Forwarded to Examiner | 0 | 0 | 0 |
| 26 | 08/21/2009 | | IDSC | Information Disclosure Statement considered | 0 | 0 | 0 |
| 22 | 08/21/2009 | 07/29/2009 | M844 | Information Disclosure Statement (IDS) Filed | 23 | 20 | 0 |
| 19 | 08/21/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | 0 | 0 | 0 |
| 20 | 07/29/2009 | | ELC | Response to Election / Restriction Filed | 0 | 0 | 0 |
| 17 | 06/29/2009 | | NCTRS | Mail Restriction Requirement | 0 | 0 | 0 |
| 16 | 06/29/2009 | | CTRS | Requirement for Restriction / Election | 0 | 0 | 0 |
| 33 | 06/25/2009 | | RCAP | Reference capture on IDS | 0 | 0 | 0 |
| 32 | 06/25/2009 | | M844 | Information Disclosure Statement (IDS) Filed | 0 | 0 | 0 |
| 25 | 06/25/2009 | | IDSC | Information Disclosure Statement considered | 0 | 0 | 0 |
| 18 | 06/25/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | 0 | 0 | 0 |
| 13 | 11/20/2008 | | PG-ISSUE | PG-Pub Issue Notification | 0 | 0 | 0 |
| 12 | 09/18/2008 | | DOCK | Case Docketed to Examiner in GAU | 0 | 0 | 0 |
| 11 | 08/29/2008 | | OIPE | Application Dispatched from OIPE | 0 | 0 | 0 |
| 9 | 08/14/2008 | | PGPC | Sent to Classification Contractor | 0 | 0 | 0 |
| 8 | 08/14/2008 | | FLRCPT.O | Filing Receipt | 0 | 0 | 0 |
| 7 | 08/14/2008 | | M903 | Notice of DO/EO Acceptance Mailed | 0 | 0 | 0 |
| 10 | 08/12/2008 | | 371COMP | 371 Completion Date | 0 | 0 | 0 |
| 5 | 08/12/2008 | | OATHDECL | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant | 0 | 0 | 0 |

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